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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,753	06/11/2001	Jose-Luis Abad-Peiro	CH919980004US1 (590.059)	6136
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EXAMINER TINKLER, MURIEL S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/787,753

Applicant(s)

ABAD-PEIRO ET AL.

Examiner

MURIEL TINKLER

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-9, 21-26 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-9, 21-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application has been reviewed. The status of the claims is as follows: claims 1-20 were previously pending; claim 1, 2, 5-7, have been amended; claims 3, 4 and 10-20 have been cancelled; claim 31 has been added; therefore, claims 1, 2, 5-9 and 21-31 are currently pending and have been examined. The rejections are as follows.

Response to Amendment

1. The amendments have been reviewed against the specification and an issue/error has been spotted. Claim 1 has been amended to include the following limitations: wherein the one or more requests for product comprise one or more requests for product information and product order information. The Examiner could not find support for this limitation in the specification. Instead, the specification discloses that the user requests product information and then the system sends the user product information and product order information. More specifically, "requesting" both product information AND product order information is not the same as requesting only product information and THEN being sent both product information and product order information [see pages 14 (lines 5-12 and 20-30); page 15 (line 10); page 17 (lines 1-6 and 24-26)].

Response to Arguments

4. The Applicant notes that an additional interview will be held before the issuance of another Office Action. However, the Applicant was told to contact the Examiner as soon as a response was filed. The Examiner did not receive any contact from the Applicant after the response was filed. Therefore, this Office Action is being sent without an additional interview.
5. Applicant's arguments, see page 11, filed December 4, 2009, with respect to the 35 USC 101 Rejection of claims 1-20 have been fully considered and are persuasive. The 35 USC 101 Rejection of claims 1-20 has been withdrawn.
6. Applicant's arguments filed December 4, 2009, with respect to the Rowney reference have been fully considered but they are not persuasive. The Applicant points out that the invention as claimed is a clearly different system and Rowney (see pages 12-15). However, the Examiner contends that the way the claims are written, still allows for two separate communications links "between" the user and the gateway (third party). However, with regard to compact prosecution, the Examiner has interpreted the new limitations as follows:
 7. The amendments to claim 1 disclose: receiving a request for product from user computing devices utilizing a first network link between the user and the certified trusted third party. The Examiner points out that Rowney does disclose a first communications link that is between the user and the third party gateway (see element 150).
 8. The amendments to claim 1 also disclose: transmitting one or more order requests from the certified trusted third party (payment gateway) utilizing a second

network link between the gateway and the merchants. The Examiner points out that Rowney does disclose a second communications link that is between the third party gateway and the merchant (see element 170).

9. The Examiner believes that the Applicant is implying that the user is directly connected to the third party gateway. The Examiner believes that this layout is used in order to enable the last limitation of claim 1, which discloses that only the third party "need know" an identity of the users. The Examiner further points out that "need know" is not a definitive phrase. Therefore it would not be necessary, according to the claims, for the user to remain anonymous to the merchant. In any case, the Examiner will treat the phrase, "need know" as, "it would not be necessary for" the merchant to know the user in order to process the transaction. The Examiner cites Sirbu et al. (US 5,809,144) as disclosing a purchasing system that allows for separation between the merchant and the user by allowing the user (element 10) and the merchant (element 22) to each connect to the third party ("product server", element 57) independently, see figure 4. Rowney discloses various systems (such as Sirbu), electronic funds transfer systems, as well known in the art, see column 1 (line 55) through column 2 (lines 27, 56-67) and column 3 (lines 1-45).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1, 7, 24 and 25 contain the limitation "wherein the one or more requests for product comprise one or more requests for product information and product order information". There is no support for this limitation in the specification. However, for purposes of compact prosecution, the Examiner has found prior art that discloses a request for product information and then being sent both product information and product order information.

Claim Rejections - 35 USC § 102

10. Claims 7-9, 24, 25 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowney et al. (US 5,987,140), hereafter referred to as Rowney.
11. Regarding claims 7, 9, 24, 25 and 29, Rowney discloses:
- a. A computerized method for securely transacting electronic commerce in an insecure network in the Abstract
 - b. Operating between a user and merchants, where user has commercial relationship with certified trusted third party in column 1 (line 37) through column 2 (line 6)

- c. Utilizing a network link between the user and trusted third party and merchants in figure 1B
- d. Utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42)
- e. Utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).
- f. Authentication using a certificate improving security of communications protocol in column 1 (line 37) through column 2 (line 6) and column 11 (lines 14-17).
- g. a first communications link that is between the user and the third party gateway (see element 150).
- h. Specifically regarding claim 25: Rowney discloses a server (Abstract) with a central processing unit (element 10 of figure 1A)
- i. The client communicates with a hello message in order to start communications with a merchant (see column 10, line 25 through column 12, line 11).
- j. Product information and product order information (i.e. payment information) is then sent to the customer [see column 11, line 59 through column 12, line 11; and, fig. 2, elements #210-270 and fig. 3, elements #315, #325].
- k. Completing the entire transaction using the certified trusted third party (see fig. 1B, column 10, lines 4-19).

12. Regarding claim 8, Rowney discloses the use of the JAVA protocol in column 4 (lines 20-31).

13. Regarding claim 27, Rowney discloses a keyboard (element 24 of figure 1A) and a card reader—"support for configuring and installing the Internet payment capability utilizing existing host point-of-sale technology, see column 15 (lines 23-56). The Examiner also points out that the GUI is capable of receiving information from the card and processing the payments.

14. Regarding claim 28, Rowney discloses receiving keyboard input, see element 24 and column 13 (lines 29-67).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1, 2, 5, 6, 21-23 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney in view of Sirbu et al. (US 5,809,144), hereafter referred to as Shirbu.

18. Regarding claims 1 and 31, Rowney discloses:

- a. A computerized method for securely transacting electronic commerce in an insecure network in the Abstract

- b. Operating between a user and merchants, where user has commercial relationship with certified trusted third party in column 1 (line 37) through column 2 (line 6)
- c. Utilizing a network link between the user and trusted third party and merchants in figure 1B
- d. Utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42)
- e. Utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).
- f. Authentication using a certificate improving security of communications protocol in column 1 (line 37) through column 2 (line 6) and column 11 (lines 14-17).
- g. a first communications link that is between the user and the third party gateway (see element 150).
- h. Specifically regarding claim 25: Rowney discloses a server (Abstract) with a central processing unit (element 10 of figure 1A)
- i. a first communications link that is between the user and the third party gateway (see element 150).
- j. a second communications link that is between the third party gateway and the merchant (see element 170).

- k. The client communicates with a hello message in order to start communications with a merchant (see column 10, line 25 through column 12, line 11).
 - l. Product information and product order information (i.e. payment information) is then sent to the customer [see column 11, line 59 through column 12, line 11; and, fig. 2, elements #210-270 and fig. 3, elements #315, #325].
19. As disclosed above, the last limitation of claim 1 discloses the phrase, "only the certified trusted third party knows an identity of one or more users". Rowney discloses various systems (such as Sirbu), electronic funds transfer systems, as well known in the art, see column 1 (line 55) through column 2 (lines 27, 56-67) and column 3 (lines 1-45). However, Rowney does not specifically disclose a system where the merchant does not have to contract the user directly. The Examiner cites Sirbu et al. (US 5,809,144) as disclosing a purchasing system that allows for separation between the merchant and the user by allowing the user (element 10) and the merchant (element 22) to each connect to the third party ("product server", element 57) independently, see figure 4. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Rowney to allow the user to contact the payment gateway directly, without having to go through the merchant, because this type transaction was old and well known in the art at the time this invention was made.
20. Regarding claim 5, Rowney discloses providing confirmation of payment (the payment capture response) in figure 13F (element 925).

21. Regarding claim 6, Rowney discloses the information in claim 1. Rowney also discloses: utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42); and, utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).

22. Regarding claim 22, Rowney discloses the use of the SET payment protocol in column 4 (lines 59-62).

23. Regarding claim 23, Rowney discloses establishing a trusted third party via an authentication/certificate in column 11 (lines 14-17) and receiving a request from a non-certified party, see figure 4 and column 12 (lines 13-24).

24. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Sirbu as applied to claim 1 above, and further in view of Shavit (US Patent 4,799,156), hereafter referred to as Shavit.

25. Regarding claims 2 and 18, Rowney discloses a terminal interface in figure 1A (element 38), the processing user requests at using a computing device (see figure 1A), and presenting an interactive window and allowing a user to choose competitive products in column 2 (lines 7-42). Rowney does not specifically disclose the use of insurance services. Shavit discloses that a payment / transaction system can interconnect with insurance services in column 7 (lines 6-9). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Rowney to include the act of connecting to insurance services because

this type of connection was old and well known in the art at the time this invention was made and according to Shavit, is also allows for businesses to achieve additional levels of efficiency (see column 1, lines 13-23).

26. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Sirbu as applied to claim 1 above, and further in view of Rosen (US 5,671,280), hereafter referred to as Rosen.

27. Regarding claim 21, Rowney and Sirbui do not specifically disclose the use of a mobile communications devices. Rosen discloses the use of mobile communications devices in commercial payment systems, see column 5 (lines 30-38). Therefore, it would have been obvious to a person having ordinary skill in the art at the time this invention was made to modify Rowney and Sirbu to include the use of mobile communications devices because it sets up communication with devices used in the "outside world" (see column 5, lines 31-32), thus allowing access to the system by more users.

28. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Fox et al. (US Patent 6,560,581), hereafter referred to as Fox.

15. Regarding claim 26, Rowney discloses: a "direct or physical" interfaces for the user in figure 1A, element 28; a keyboard (fig. 1A, element 24); and, a card reader configured to receive and process payments made with a bank or smart card. Rowney does not disclose an a card reader. However, Fox discloses a card reader used in

electronic commerce for payment of a transaction (see Abstract, fig. 10, element #160 and column 16, lines 46-58). Therefore, it would be obvious to a person having ordinary skill in the art at the time this invention was made to modify Rowney to include the use of a card reader because it is a convenient and efficient way for users to pay for their merchandise.

29. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney and Shavit, hereafter referred to as Shavit.

30. Regarding claim 30, the Examiner discloses that it is possible for the requests/purchases in Rowney to be insurance services. However, Rowney does not specifically disclose the use of insurance services. Shavit discloses that a payment / transaction system can interconnect with insurance services in column 7 (lines 6-9). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Rowney to include the act of connecting to insurance services because this type of connection was old and well known in the art at the time this invention was made and according to Shavit, is also allows for businesses to achieve additional levels of efficiency (see column 1, lines 13-23).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is

(571)272-7976. The examiner can normally be reached on Monday through Friday from 8:30 AM until 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Muriel Tinkler/
Examiner, Art Unit 3691